

Applicant under 35 USC 121 “to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.”

3. **Response:** Applicant traverses the restriction requirement on the grounds that: (a) there are no pending claims to the invention as disclosed in Fig. 10; and (b) though in light of (a) a restriction requirement is moot, the Office Action nevertheless in theory fails to make a *prima facie* case for a restriction requirement.

3.1. **No claims to Fig. 10.** Applicant cannot possibly elect claims to Fig. 1 or Fig. 10 for the simple reason that there are no claims to the version of the invention shown in Fig. 10 (i.e., elliptical trainer lower portion version). All pending claims are to Fig. 1 (and other figures) only.

3.1.1. As defined in the application, “Figure 1 is a perspective view of the first preferred embodiment of a dual-function treading exerciser according to the present invention” (§ 0008). “Figure 10 is a perspective view of another dual-function exerciser in accordance with the present invention in the form of an elliptical machine with movable handle assemblies” (§0017). The difference between versions of the invention shown in the two figures is in the lower body portion of the machine only, i.e., in Fig. 1 a treadmill type lower portion is depicted and in Fig. 10 an elliptical trainer type lower portion is depicted. There are no claims to an elliptical trainer type lower portion, therefore there are no claims to what the Office Action refers to as an allegedly “patentably distinct species.” The versions depicted in Figures 1 and 10 do not differ in any other aspects of the invention as claimed in the pending claims 1-8, 10-19, 21-33.

3.2. **No *prima facie* case made.** The fact that there are no claims to Fig. 10 version of the invention makes any argument for a restriction moot since there are no claims specifically to the Fig. 10 elliptical trainer version of the invention to restrict. However, even if there were (which there are not), the Office Action does not make a *prima facie* case for a restriction.

- 3.2.1. Requirements for making a *prima facie* case.¹ In making a *prima facie* case for restricting the claims of an application, an examiner must
- 3.2.1.1.(1) provide reasons why the inventions as claimed are distinct; and,
- 3.2.1.2.(2) if they are distinct, explain why the distinct inventions must be restricted on the basis of (a) separate classification, (b) separate status in the art, or (c) a different field of search.
- 3.2.2. Requirement for a *prima facie* case not met:
- 3.2.2.1. No reasons whatsoever why the inventions as claimed (much less as depicted in Fig. 1 and Fig. 10) are distinct are provided. The Office Action simply makes an assertion that the two figures (i.e., 1 and 10) disclose "patentably distinct species of the claimed invention."
- 3.2.2.2. No explanation whatsoever of why the allegedly distinct inventions must be restricted on the basis of (a) separate classification; (b) separate status in the art; or, (c) different field of search, was provided.

CONCLUSION

For the foregoing reasons, Applicant submits that the specification, drawings and all remaining pending claims are in proper form and clearly and patentably distinguish the present invention over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action Applicant respectfully solicits. No new matter has been added.

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¹ See MPEP 802.01, 808.02.